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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,559	10/24/2003	Andrew W. Stamford	CN01472KB	9131

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,559

Applicant(s)

STAMFORD ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is a divisional of SN 10/202,239. Claims 1-21 as originally filed are pending.

2. *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-3, 5 in part, drawn to bipiperidines X and Z are N, $g=0$, classified in class 546, subclass 184+. If this group is elected, generic claims 1, 9, 11, 20, 21 reading on the elected compound can be prosecuted together with the election.
- II. Claims 5, 6-8, 5 in part, drawn to piperidine compounds, X is C, Z is N, $g=0$, classified in class 546, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claims 1, 9, 11, 20, 21 reading on the elected compounds can be prosecuted together with the election.
- III. Claims 1, 9, 11, 20, 21 remaining, drawn to X is N, g is not 0 classified in class 546, subclass 79+, or X and Z are C classified in class 564 subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Further restriction will be made based on the elected species.
- IV. Claims 10, 12-16, drawn to method of treating metabolic disorder, eating disorder or diabetes, using a single active ingredient, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species of active compound and a single disease/disorder is also required.
- V. Claims 17, 19 drawn to compositions for treating metabolic disorder, eating disorder or diabetes, comprising multiple active ingredient, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed combination of active ingredients with every element named, and a single disease/disorder is also required.

Art Unit: 1625

- VI. Claim 18, drawn to method of treating metabolic disorder, eating disorder or diabetes, using first active compound and then a second active compound classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single combination with the single active first compound and the single active second compound named and a single disease/disorder is also required. Further restriction may be required.

The inventions are distinct, each from the other because:

Groups I-III compounds differ in core structure to such an extent that a reference anticipates any one group would not render the other groups obvious. Group II has been issued as the parent patent US 6,667,319. The core structures have not been recognized in the art to be a single class of compounds for the same utility. For example the X is C, Z is C core is evidenced to be MRP1 inhibiting compounds (see CA 135:472724) or chemokine receptor modulating (see Ca 142:744455). Lacking an art recognized common core is the basis of patentable distinctness and independence. Further, the search for each core is not co-extensive and extremely burdensome were restriction not made.

Inventions I-III, V and IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for treating diabetes can be practiced with a material different process for example in US 5,955,481.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1625


application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jun. 29, 2005


Celia Chang
Primary Examiner
Art Unit 1625